

NOV 29 2005

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## FACSIMILE TRANSMITTAL SHEET

TO: Mail Stop: AMENDMENT  
Commissioner for Patents

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FROM: Anita W. Magatti

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TOTAL NO. OF PAGES INCLUDING COVER  
7 pages

DATE  
November 29, 2005

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Examiner: Deepak R. Rao  
Application No. 10/761,977  
In re Application of: Deen Tulshian et al.  
Patent for: High Affinity Ligands for Nociceptin Receptor ORL-1  
Filed: 01/21/2004  
Group Art Unit: 1624  
Attorney Docket No.: CN0821KD

Dear Sir/Madam:

Transmitted herewith are:

- Fax Cover Sheet (1 page)
- Certificate of Fax Transmission sb97 (1 page)
- Transmittal Form sb21 (1 page)
- Submission of Terminal Disclaimer (1 page)
- Terminal Disclaimer to Obviate a Double Patenting (1 page)
- Fee Transmittal sb17 (1 page) in duplicate

  
Anita W. Magatti  
Attorney for Applicant, Reg. No. 29,825

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PHONE: 908-298-5067

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page 5 of 7 is missing

HW

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Docket Number: CN0821KD  
Application No: 10/761977  
Filing Date: 01/21/2004  
First Inventor: TULSHIAN, Deen

NOV 29 2005

PTO/SB/97 (09-04)  
Approved for use through 07/31/2006. OMB 0651-0031  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

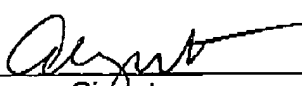
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Transmittal Form sb21 (1 page)  
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Terminal Disclaimer to Obviate a Double Patenting (1 page)  
Fee Transmittal sb17 (1 page) in duplicate

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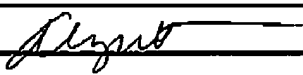
PTO/SB/21 (09-04)

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<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	10/761977	
	Filing Date	01/21/2004	
	First Named Inventor	TULSHIAN, Deen	
	Art Unit	1624	
	Examiner Name	Rao, Deepak R.	
Total Number of Pages in This Submission	7	Attorney Docket Number	CN0821KD

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement  <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input checked="" type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):  Submission of Terminal Disclaimer (1 page)
Remarks _____ Other Enclosures: Cert. of Fax Transmission (1 page) Fax Cover Sheet (1 page) Certificate of Transmission (1 page)		
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
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Printed name	ANITA W. MAGATTI	
Date	November 29, 2005	Reg. No. 29825

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Signature		
Typed or printed name		Date

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PTO/SB/17 (12-04)

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Effective on 12/08/2004.  
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).**FEE TRANSMITTAL**  
**For FY 2005**☐ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT** (\$ ) 130.00**Complete if Known**

Application Number	10/761977
Filing Date	01/21/2004
First Named Inventor	TULSHIAN, Deen
Examiner Name	Rao, Deepak R.
Art Unit	1624
Attorney Docket No.	CN0821KD

**METHOD OF PAYMENT** (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): \_\_\_\_\_

☒ Deposit Account Deposit Account Number: 19-0365 Deposit Account Name: Schering-Plough Corp.

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee

☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments

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**FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

**2. EXCESS CLAIM FEES**

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent	50	25
Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent	200	100
Multiple dependent claims	360	180

**Total Claims**      **Extra Claims**      **Fee (\$)**      **Fee Paid (\$)**      **Multiple Dependent Claims**

\_\_\_\_\_ - 20 or HP = \_\_\_\_\_ x \_\_\_\_\_ = \_\_\_\_\_      **Fee (\$)**      **Fee Paid (\$)**

HP = highest number of total claims paid for, if greater than 20

**Indep. Claims**      **Extra Claims**      **Fee (\$)**      **Fee Paid (\$)**

\_\_\_\_\_ - 3 or HP = \_\_\_\_\_ x \_\_\_\_\_ = \_\_\_\_\_

HP = highest number of independent claims paid for, if greater than 3

**3. APPLICATION SIZE FEE**

If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
_____ - 100 = _____ / 50 = _____ (round up to a whole number) x _____ = _____				

**4. OTHER FEE(S)**

Non-English Specification, \$130 fee (no small entity discount)

Other: Fee for Terminal Disclaimer to Obviate a Double Patenting ...

**Fees Paid (\$)**  
\$130.00**SUBMITTED BY**

Signature		Registration No. (Attorney/Agent) 29825	Telephone 908-298-5067
Name (Print/Type)	ANITA W. MAGATTI		Date 11/29/05

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT  
CASE CN0821KDIN THE UNITED STATES PATENT AND TRADEMARK OFFICEIn re Application of:  
Deen Tulshian et alFor Patent For:  
High Affinity Ligands for  
Nociceptin Receptor ORL-1

Serial No.: 10/761,977

Filing Date: January 21, 2004

Examiner: Deepak R. Rao

Art Unit: 1624

Schering-Plough Corporation  
Kenilworth, New Jersey 07033-0530Mail Stop Amendments  
Commissioner for Patents  
PO Box 1450  
Alexandria VA 22313-1450SUBMISSION OF TERMINAL DISCLAIMER

Sir:

This is in response to the Office Action mailed November 9, 2005, a response to which is due February 9, 2006.

Pending claims 3, 4, 7, 8, 21 and 22 were rejected for obviousness-type double patenting over the claims of co-owned US 6,727,254.

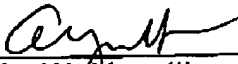
A Terminal Disclaimer over US 6,727,254, including the authorization to charge the required fee, is enclosed.

Reconsideration and withdrawal of the rejection for double patenting and allowance of claims 3, 4, 7, 8, 21 and 22 are respectfully requested.

Respectfully submitted,

11/29/05

Date

  
Anita W. Magatti  
Reg. No. 29,825  
Attorney for Applicants  
(908) 298-5067

PTO/SB/26 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031

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**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING  
REJECTION OVER A "PRIOR" PATENT**Docket Number (Optional)  
CN0821KD

In re Application of: TULSHIAN, Deen et al.

Application No.: 10/761977

Filed: 01/21/2004

For: HIGH AFFINITY LIGANDS FOR NOCICEPTIN RECEPTOR ORL-1

The owner, SCHERING CORPORATION, of 100% percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term prior patent No. 6,727,254 as the term of said prior patent is defined in 35 U.S.C. 154 and 173, and as the term of said prior patent is presently shortened by any terminal disclaimer. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of the term of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of the prior patent, "as the term of said prior patent is presently shortened by any terminal disclaimer," in the event that said prior patent later:

expires for failure to pay a maintenance fee;

is held unenforceable;

is found invalid by a court of competent jurisdiction;

is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321;

has all claims canceled by a reexamination certificate;

is reissued; or

is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney or agent of record. Reg. No. 29829

  
Signature11/29/05  
Date

ANITA W. MAGATTI

Typed or printed name

908-298-5067

Telephone Number

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) included.

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\*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).  
Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

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